

and 15 have been cancelled, and the rejection is therefore no longer relevant regarding these claims.

To anticipate a claim under § 102, a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). In view of the foregoing authority, the Applicant respectfully submits that the cited reference fails to support the asserted rejection.

Donovan fails to anticipate the present invention as claimed for at least the reason that Donovan does not disclose receiving a device identifier or attribute for a mobile communication device via a communication network, wherein the device identifier or attribute is correlated with information concerning what services the mobile communication device has a technical capability to access, as required by each of claims 1, 6, 11 and 12. Moreover, Donovan is silent as to determining, based on the received device identifier or attribute and the corresponding information, whether the mobile communication device is capable of receiving a requested service, as further required by claims 1, 6, 11 and 12.

Instead, Donovan relates to a method of validating a subscriber terminal of a telecommunications network. Donovan is concerned with reducing signaling requirements between a local office and a central office pursuant to the validation. To this end, Donovan describes contacting the central office for validation of a terminal only after a predetermined number of accesses by the terminal to the network have been made, or if the same subscriber is using a different terminal to access the network. See, e.g., Donovan at col. 2, lines 45-48 and lines 62-66; col. 3, lines 19-23. However, there is no teaching in Donovan of determining whether a mobile device has the technical capability to access a particular network service, as called for in the rejected claims.

More specifically, for example, the Examiner cites col. 3, lines 63-67 of Donovan in support of the proposition that Donovan anticipates "accessing a device capabilities database" (Office Action, p. 3, lines 6-7). However, the cited passage only refers to an "access status". This access status relates to network security, not

to device capability; i.e., to *authorization* or *permission* of a given terminal to access a network (see Donovan, col. 5, lines 40-41).

In view of the foregoing, Donovan cannot meet the requirements of a rejection anticipation as set forth above. Withdrawal of the rejection of claims 1, 6, 11 and 12 as anticipated by Donovan is therefore respectfully requested.

Claim 2 was rejected under 35 USC 103(a) as being unpatentable over Donovan in view of Wild et al. (Wild) (U.S. 5,862,480).

To establish a *prima facie* case of obviousness under § 103, all claim limitations of a claimed invention must be taught or suggested by the prior art. See MPEP, § 2143.03 and *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In view of the foregoing authority, the cited references fail to support the asserted rejection.

Claim 2 depends on claim 1 and consequently incorporates its features. As demonstrated above, Donovan does not teach all the features of claim 1. Moreover, Wild fails to remedy the deficiencies in Donovan since, like Donovan, Wild does not teach or suggest receiving a device identifier or attribute for a mobile communication device via a communication network, wherein the device identifier or attribute is correlated with information concerning what services the mobile communication device has a technical capability to access, and determining, based on the received device identifier or attribute and the corresponding information, whether the mobile communication device is capable of receiving a requested service, as required by claim 1.

The Examiner cites Wild, col. 10, lines 8-50 as support for the contention that Wild teaches "proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device" (the above-identified Office Action, p. 6, paragraph 2). However, like Donovan, Wild relates to authorization or permission for a mobile device to utilize a network, not to whether a mobile device has a technical capability to utilize a given service of a network. By contrast, according to the present invention, filtering with respect to a mobile device's capability to utilize a particular service of a network may be performed (see, e.g., the present specification at p. 8, lines 22-24). The service

could be, for example, a special billing plan such as Digital One Rate (specification, lines 8-10).

Wild does not suggest any capacity for discriminating with respect to device capabilities on a service level, based on a device identifier or attribute, in contrast to the present invention. Rather, as described in the cited passage in Wild, once it is determined that a subscriber unit (SU) can communicate via a particular network's air interface standard (modulation scheme, frequency band, etc.), it is then determined whether the SU is *authorized* or *permitted* to utilize the network, not which of services offered by the network a device has the capability to utilize. See Wild, col. 10, lines 34-35.

In view of the foregoing, Donovan and Wild cannot render claim 2 obvious, either independently or in combination. Accordingly, withdrawal of the rejection of claim 2 as unpatentable over Wild is respectfully requested.

Claims 4 and 7 were rejected under 35 USC 103(a) as being unpatentable over Donovan in view of Fehnel WO 97/34438.

Requirements for sustaining a rejection for obviousness under § 103 have been outlined above. The combination of Donovan and Fehnel clearly fails to meet the requirements with respect to claims 4 and 7. Claims 4 and 7 each incorporate, by dependency, the features of claims 1 and 6, respectively. As discussed above, Donovan fails to teach receiving a device identifier or attribute for a mobile communication device via a first communication network, wherein the device identifier or attribute is correlated with information concerning what services the mobile communication device has a technical capability to access, and determining, based on the received device identifier or attribute and the corresponding information, whether the mobile communication device is capable of receiving a requested service, as required by claims 1 and 6.

Fehnel does not remedy deficiencies in Donovan. Fehnel relates to directing dual mode mobile stations, i.e., mobile stations capable of communicating via both analog and digital channels, to the more efficient digital channels. The Examiner points to page 20, lines 1-14 as teaching features of the claimed invention. However, nothing in this portion of the reference (or elsewhere) suggests

determining, from a received device identifier or attribute and correlated device capabilities information, whether a mobile device is capable of receiving a requested service, as called for in claims 1 and 6. More specifically, a DCCH (digital control channel) as discussed in Fehnel is not a service as called for in the claims of the present application; rather, a DCCH is a communication path implemented by a time-division multiplexing scheme.

Considering the above, Donovan and Fehnel cannot render the invention as recited in claims 4 and 7 obvious, either independently or in combination. Withdrawal of the rejection of claims 4 and 7 as unpatentable over Donovan and Fehnel is therefore respectfully requested.

Claims 3 and 5 were rejected under 35 USC 103(a) as being unpatentable over Donovan in view of Frager (U.S. Patent No. 6,018,652).

Along lines discussed earlier, claims 3 and 5 incorporate the features of claim 1 by dependency, and Donovan does not anticipate claim 1. Moreover, even the combination of Donovan with Frager cannot render claim 1 obvious, since Frager does not suggest determining, from a received device identifier or attribute and correlated device capabilities information, whether a mobile device is capable of receiving a requested service, as required by claim 1. Instead, Frager only describes a billing system for a cellular communications system where subscribers are billed at a special rate within agreed-upon "charging areas." However, there is no suggestion in Frager of determining a mobile device's capabilities for receiving a requested service. Thus, the asserted rejection cannot be sustained, and withdrawal of the rejection of claims 3 and 5 as unpatentable over Donovan and Frager is respectfully requested.

Claims 8, 10 and 13 were also rejected under 35 USC 103 (a) as unpatentable over Donovan and Frager.

Claim 8 depends on claim 6 and thus is not rendered obvious by the combination of Donovan and Frager, as discussed in connection with claims 3 and 5, above. Claims 10 and 13 each recite applying a device identifier to an equipment capabilities filter, where the equipment capabilities filter comprises information concerning what services the device has a technical capability to access. This

feature has been demonstrated to be absent from both Donovan and Frager in the foregoing discussion. Accordingly, withdrawal of the rejection of claims 8, 10 and 13 as unpatentable over Donovan and Frager is respectfully requested.

In light of the above discussion, and since the amendments to the claims set forth herein in no way raise new issues and clearly place the application in condition for allowance, the Applicant respectfully requests entry of the amendments, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

The Examiner is invited to contact the undersigned at (202) 220-4323 to discuss any matter concerning this application. The Office is authorized to charge any fees under 37 C.F.R. 1.16 or 1.17 related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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**VERSION OF AMENDMENTS MARKED UP TO SHOW CHANGES MADE**

**In the claims:**

1. (Twice amended) A method for registering a mobile communication device to a service comprising:

receiving a device identifier for the mobile communication device via a [first] communication network, wherein the device identifier [provides information which the mobile communication device is capable of receiving] is correlated with information concerning what services the mobile communication device has a technical capability to access;

receiving, via the [first] network, a request for a [first] service to be provided to the mobile communication device;

accessing a device capabilities database that includes the information, using the received device identifier;

determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the requested service; and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device.

6. (Twice amended) A method for registering a mobile communication[s] device to a service, comprising:

receiving a device attribute for the mobile communication device via a [first] communication network, wherein the device attribute [provides information which the mobile communication device is capable of receiving] is correlated with information concerning the technical capability of the mobile communication device to receive a requested service;

receiving, via the [first] network, a request for a [first] service to be provided to the mobile communication device;

accessing an attribute database that includes the information, using the received device attribute;

determining, based on the received device attribute and the corresponding information, whether the mobile communication device is [permitted to receive] capable of receiving the requested service; and

when the mobile communication device is determined to be [permitted to receive] capable of receiving the requested service, setting up the requested service for the mobile communication device.

10. (Amended) A method for ascertaining whether to register a mobile communication device to a given service, the method comprising:

applying a device identifier to an equipment capabilities filter, the equipment capabilities filter comprising information concerning what services the device has a technical capability to access;

applying a home location identifier to a geographic eligibility filter; and

registering the mobile communication device to the given service if the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively.

11. (Amended) A program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communication device to a service, the method comprising:

receiving a device identifier for the mobile communication device via a [first] communication network, wherein the device identifier [provides information which the mobile communication device is capable of receiving] is correlated with information concerning what services the mobile communication device has a technical capability to access;

receiving, via the [first] network, a request for a [first] service to be provided to the mobile communication device;

accessing a device capabilities database that includes the information, using the received device identifier;

determining, based on the received device identifier and the corresponding information, whether the mobile communication device is capable of receiving the requested service; and

when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device.

12. (Amended) A program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communications device to a service, the method comprising:

receiving a device attribute for the mobile communication device via a [first] communication network, wherein the device attribute [provides information which the mobile communication device is capable of receiving] is correlated with information concerning the technical capability of the mobile communication device to receive a requested service;

receiving, via the [first] network, a request for a [first] service to be provided to the mobile communication device;

accessing an attribute database that includes the information, using the received device attribute;

determining, based on the received device attribute and the corresponding information, whether the mobile communication device is [permitted to receive] capable of receiving the requested service; and

when the mobile communication device is determined to be [permitted to receive] capable of receiving the requested service, setting up the requested service for the mobile communication device.

13. (Amended) A program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for ascertaining whether to register a mobile communication device to a given service, the method comprising:

applying a device identifier to an equipment capabilities filter, the equipment capabilities filter comprising information concerning what services the device has a technical capability to access;

applying a home location identifier to a geographic eligibility filter; and

registering the mobile communication device to the given service if the device identifier and home location identifier pass through the equipment capabilities filter and geographic eligibility filter, respectively.